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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,389	12/15/2003	Thomas E. Creamer	BOC9-2003-0088 (459)	6219
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Novak Druce + Quigg LLP CityPlace Tower, 525 Okeechobee Blvd. Fifteenth-Floor WEST PALM BEACH, FL 33401				
EXAMINER				
NOONAN, WILLOW W				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/736,389

Applicant(s)

CREAMER ET AL.

Examiner

Willow Noonan

Art Unit

2446

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 25-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 25-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 December 2003 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The instant application having Application No. 10/736,389 has a total of 9 claims pending in the application; there are 3 independent claims and 6 dependent claims, all of which are ready for examination by the examiner. There are 21 cancelled claims.

Response to Arguments

2. Applicant's arguments filed 4/7/2009 have been fully considered but they are not persuasive.

Applicant first argues that the AA credentials taught by Benenati are from a user rather than from a mobile service provider. However, Benenati teaches that the service provider may provide a key to an authentication client to be used in a future authentication process. See Benenati at p. 4, paragraph 38 ("Upon verification of the signature the AAA entity authorizes (Step S340) the user 110 and may send (Step S350) a key for encryption and a new key material to be used in a future authentication process."). Thus Benenati does teach authentication credentials provided by a service provider.

Applicant next argues that Benenati teaches away from using SIP. However, Benenati simply teaches that single set of credentials may be used across multiple protocol layers. See *id.* at p. 1, paragraph 7 ("Additionally, the user may employ a single set of authentication and authorization (AA) credentials, usable over multiple communication protocol layers."). Paragraph 34 of Benenati, which Applicant cites in

support of his proposition, refers to the shortcomings of the prior art authentication mechanisms that require separate authentication mechanisms at different layers. See *id.* at paragraph 34.

Applicant finally argues that Benenati does not disclose the specific authentication steps. However Benenati does teach these steps. See *id.* at p. 3, paragraph 32-33.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3, 25, 27-28, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Benenati** (U.S. Patent App. Pub. No. 2004/0193712) in view of **Faccin** (U.S. Patent App. Pub. No. 2003/0014668) and further in view of **Pailer** ("A Service Framework for Carrier Grade Multimedia Services using Parlay APIs over a SIP system").

Regarding claims 1, 25, and 28, Benenati teaches a method of authenticating a mobile communication device within a mobile network, which is a voice network, and a wireless network, which is a data network. See Benenati at p. 1, paragraph 14. Benenati teaches providing a mobile communication device configured to communicate over the mobile network and the wireless network. See *id.* Benenati teaches the

mobile communication device receiving authentication data from a mobile service provider over the mobile network when the mobile communication device is within communication range of the mobile network. *See id.* at p. 4, paragraph 38 ("Upon verification of the signature the AAA entity authorizes the user and may send a key for encryption and a new key material to be used in future authentication process.").

Benenati teaches the mobile communication device forming a token using the authentication data received from the mobile service provider communications network and sending the token to a server via a wireless communications link over the wireless networks. *See id.* at p. 4, paragraph 39 ("thus it may become possible for client software at the user to automatically supply the user's authentication credentials whenever the user moves between air interface technologies"). Benenati teaches the server interpreting the token and forming a request for authentication using data specified by the token; and the server sending the request for authentication of the mobile communication device to the mobile service provider. *See Benenati* at p. 3, paragraph 32-33 ("resolve the authoritative AAA server and to forward the authentication request message to the appropriate H-AAA server"). Benenati teaches the mobile service provider confirming or denying the request for authentication by sending a response to the server, the server receiving the response from the mobile service provider and sending a reply to the mobile communication device over the wireless communications link indicating whether the request for authentication was confirmed, and the mobile communication device receiving [[a]] the reply from the SIP server. *See Benenati* at p. 4, paragraph 38 ("Upon verification of the signature the AAA

entity authorizes the user and may send a key for encryption and a new key material to be used in future authentication process.”).

Benenati does not teach that the authentication server is a Session Initiation Protocol (SIP) server. However, Faccin teaches that it is well known to use SIP for authenticating communication devices in a network. See Faccin at fig. 1; Faccin at p. 2, paragraph 26. It would have been obvious to one of ordinary skill to use Faccin's technique in Jones' system because Faccin teaches that the disclosed technique may be used to authenticate a subscriber in a mobile terminated call to increase system security. See Faccin at p. 1, paragraph 10.

Modified Benenati does not teach that the request for validation uses Parlay. However, Pailer teaches that it is well known map SIP functionality to Parlay services. See Pailer, *Abstract*. It would have been obvious to use Pailer's technique in Jones' system because Pailer teaches that the use of the Parlay APIs may speed up application development and increase interoperability. See Pailer, *Abstract*.

Regarding claims 3, 27, and 30, Benenati teaches that the wireless network is compliant with an 802.11 wireless communications protocol. See *id*.

5. Claims 2, 26, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Benenati** (U.S. Patent App. Pub. No. 2004/0193712) in view of **Faccin** (U.S. Patent App. Pub. No. 2003/0014668), further in view of **Pailer** (“A Service Framework for Carrier Grade Multimedia Services using Parlay APIs over a SIP system”), and further in view of **Applicant's admitted prior art** (hereafter "AAPA").

Regarding claims 2, 26, and 29, AAPA teaches that the wireless network is compliant with at least one of an 802.16, 802.20, or 802.15 wireless communications protocol. *See* present application at p. 2. It would have been obvious to one of ordinary skill to use any of the wireless standards taught by AAPA in Benenati's system because Benenati teaches that the disclosed invention may be applied to any transmission system. *See* Benenati at p. 1, paragraph 14.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Willow Noonan whose telephone number is (571)270-1322. The examiner can normally be reached on Monday through Friday, 7:30 AM-5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Pwu can be reached on (571) 272-6798. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Willow Noonan/
Examiner, Art Unit 2446

/Jeffrey Pwu/
Supervisory Patent Examiner, Art Unit 2446